

REMARKS

Applicants have amended claim 23 and cancelled claim 24 without prejudice as set forth above. No new matter has been added by way of these amendments. Applicants note with appreciation the Office for his determination that claims 1-3, 7, 9-16, and 18-20 are allowable over the prior art of record. In view of the above amendments and the following remarks, reconsideration of the outstanding office action is respectfully requested.

The Office has rejected claim 23 under 35 U.S.C. 102(e) as being anticipated by U.S. Patent No. 7,500,967 to Thorley et al. (Thorley) and claims 23 and 24 under 35 U.S.C. 103(a) as being unpatentable over European Patent No. 0 566 882 to Demetrio (Demetrio).

Neither Thorley nor Demetrio, taken alone or in combination, disclose or suggest, “wherein the second body member is adapted to be engageable by said plunger so that depression of said plunger triggers said rotational disengagement of said first body member and said second body member and wherein the first body member comprises two or more projections capable of slidably engaging respective slots in the plunger to guide rotation of the plunger in use” as now recited in claim 23.

With respect to Thorley, the Office has asserted this reference discloses, “a spring retainer for a syringe (Figures) that comprises a barrel (412), a plunger (415), a spring (480) and a retractable needle (413), said spring retainer comprising a housing having first (481) and second (418) body members adapted to releasably maintain said spring in a compressed state until rotational disengagement of said first and second body members allow decompression of said spring to facilitate retraction of said retractable needle into said barrel (Summary; Figs 14a-c); wherein the second body member is adapted to be engable by said plunger so that depression of said plunger triggers said rotational disengagement of said first body member and said second body member (Figs 14a-c).” Additionally, the Office asserts, “Thorley et al discloses including a first body member (418) with projections (422a, b) that slidingly engage the slots in the plunger (e.g. 416) to guide rotation of the plunger in use.”

However, contrary to the Office’s assertion it is the cap 481 in Thorley that is coupled to plunger 415 and collar 418 is mounted to the barrel. By way of example only, the

Office's attention is respectfully directed to column 7, lines 26-38 of Thorley which are set forth below:

"Referring now to FIG. 14A, initially in use, first projection 422A is located in first slot 416 and second projection 422B is located in retraction slot 429, maintained in this position by spring 480 which bears against cap 481 (in use mounted to plunger 415) and collar 418. First slot 416 includes an abutment in the form of ramp 474. This ramp 474 does not restrict slidable movement of projection 422A in first slot 416. An abutment 475 is also located in retraction slot 429. Abutment 475 in retraction slot 429 is block-shaped, although abutment 475 may be in the form of a ramp. Limited slidable movement of second projection 422B (relative to plunger 415) is allowed in the direction of the arrow in FIG. 14A, such as when initially depressing plunger 415 to expel air from barrel 412." (emphasis added)

Further, even assuming *arguendo* that the cap 481 and collar maintain the spring in a compressed state and that rotation of the plunger with cap 481 relative to the fixed collar 481 is rotation of "a second body member" relative to a "first body member" and that cap 481 and collar 418 are "engaged" via compressed spring 480, as the Office has asserted (which it does **not**), Thorley also does not disclose or suggest rotational disengagement of cap 481 and collar 418. Thus, there is no teaching or suggestion in Thorley that the device disclosed therein includes a "depression of said plunger triggers said rotational disengagement of said first body member and said second body member" to allow the spring to decompress as now recited in claim 23. By way of example only, the Office's attention is directed to the Abstract of Applicant's application which states:

"A spring retainer (60) for a syringe (10) that has a barrel (40), a plunger (20), a spring (90) and a retractable needle (50) that can couple with the plunger for spring-driven retraction of the coupled needle and plunger. The spring retainer has first (70) and second (80) body members that cooperate to releasably maintain the spring in a compressed state until the plunger is coupled to the retractable needle after depression of the plunger to deliver the fluid contents of the syringe. Depression of the plunger triggers rotational disengagement of the first and second body members to allow decompression of the spring which forces retraction of the needle into the barrel. Rotational disengagement of the first and second body members also assists rotation of the plunger into a final, inoperable position." (Emphasis added)

In sharp contrast, the spring 480 in Thorley is released by the user releasing pressure on cap 481, but the cap 481 and collar 418 are never disengaged because one end of the decompressing spring 480 always bears against cap 481 and the other against collar 418. Furthermore, rotation of the plunger 415 and cap 481 relative to collar 418 occurs as result of spring 480 decompression (see column 8 lines 22-29 of Thorley). Therefore, Thorley does not disclose or suggest “depression of said plunger triggers said rotational disengagement of said first body member and said second body member” to allow the spring to decompress as now recited in claim 23.

With respect to Demetrio, the Office has asserted this reference discloses:

[A] spring retainer for a syringe (Figures) that comprises a barrel (2), a plunger (10), a spring (40) and a retractable needle (15), said spring retainer comprising a housing having first (21) and second (5, 6) body members adapted to releasably maintain said spring in a compressed state until rotational disengagement of said first and second body members allow decompression of said spring to facilitate retraction of said retractable needle into said barrel (Figs 6-9); wherein the second body member is adapted to be engagable by said plunger so that depression of said plunger triggers said rotational disengagement of said first body member and said second body member (Figs 6-9), the plunger having two projections (32) engagable with respective slots (33) in the first body member, the second body member having recesses (22) engagable by tabs (20) on the first body member, where disengagement of the 1st and 2nd body members is capable of allowing rotation of the bodies relative to each other (Figs 6-9). With respect to claim 23 and 24, where the 1st body member (20) has slots (33) and the plunger has projections (32). However, Demetrio had projections on the plunger and slots on the 1st or 2nd body members (depending on which claims) rather than the claimed opposite. It would have been obvious to one having ordinary skill in the art at the time the invention was made to merely reverse the projections and slots on the plunger and 1st or 2nd body members because courts have held this to be an obvious design choice within the ordinary skill in the art (see MPEP (IV)(A)).

Accordingly, the Office has characterized Demetrio as disclosing a spring retainer for a syringe wherein the retainer comprises a housing having first body member 21 and second body member 5, 6 that maintain spring 40 in a compressed state until rotational disengagement of first body member 21 and second body member 5, 6 allow spring 40 to decompress and facilitate needle retraction. The Office has asserted that the second body member 5, 6 of

Demetrio is adapted to be engaged by plunger 10 of Demetrio so that depression of the plunger triggers rotational disengagement of the first body member 21 and second body member 5, 6.

However, contrary to the Office's assertions it is the alleged first body member 21 of Demetrio that is adapted to be engaged by the plunger 10 of Demetrio and **not** the second body member 5, 6 of Demetrio being engageable by the plunger 10 as suggested by the Office. By way of example only, the Office's attention is directed to column 4, lines 1-10 of Demetrio which states:

"A cavity 30 is defined inside the coupling body 21 of the needle 15, and a pin 31 can be inserted therein; said pin 31 is arranged at the end of the plunger-like piston 10 and is provided with diametrical protrusions 32.

Coupling between the plunger-like piston (10) and the needle coupling body (21) is provided so that at the end of the injection stroke, as will become apparent hereinafter, the plunger-like piston disengages the needle from the cylindrical body." (emphasis added)

Accordingly, there is no teaching or suggestion in Demetrio that the alleged second body member 5, 6 disclosed therein can in any way be engaged by the plunger 10. In this regard, it is noted that all figures and teaching throughout Demetrio illustrate and describe a device having first body member 21 that is adapted to be engaged by the plunger 10. Therefore, the plunger 10 of Demetrio could not be made to engage the alleged second body member 5, 6 to thereby rotationally disengage it from the alleged first body member 21 to trigger spring 490 decompression. Thus, Demetrio does not disclose or suggest, "depression of said plunger triggers said rotational disengagement of said first body member and said second body member" to allow the spring to decompress as now recited in claim 23.

Further, the Office asserts that in Demetrio the plunger 10 comprises projections 32 that engage slots 33 in first body member 21, not the opposite as recited in the claim. The Office then asserts it is merely an obvious design choice to reverse Demetrio to have the slots on the plunger and the projections on the first or second body members. However, contrary to the Office's assertions it would **not** have been obvious or a matter of mere design choice to reverse Demetrio to arrive at the spring retainer as set forth in claim 23.

First, in Demetrio the alleged second body member 5, 6 is located in a position on the barrel where it cannot be engaged by the plunger 10. As described above, there is no teaching or suggestion in Demetrio that the alleged second body member 5, 6 can in any way be engaged by the plunger 10. Accordingly, the Office has not provided any reasoning or evidence that the plunger 10 of Demetrio could be made to engage the alleged second body member 5, 6 to thereby rotationally disengage it from the alleged first body member 21 to trigger spring 490 decompression.

Secondly, the non-obvious and difficult reversal of Demetrio, as proposed by the Office, would be a pre-condition to including slots on plunger 10 and projections 32 on the alleged first body member 21 so that first body member 21 guides rotation of plunger 10. Demetrio specifically discloses pin 31 having radial protrusions 32 and a single notch 35 for the protrusions. By way of example only, the Office's attention is directed to column 4, lines 1-5 and column 5, lines 42 - 46 of Demetrio which states:

“A cavity 30 is defined inside the coupling body 21 of the needle 15, and a pin 31 can be inserted therein; said pin 31 is arranged at the end of the plunger-like piston 10 and is provided with diametrical protrusions 32.” (emphasis added)

“As previously mentioned, there is a single notch 35 for the protrusions 32, so that during its insertion in the syringe the needle tilts, so that subsequent reuse of the syringe is not possible since the needle cannot exit.” (emphasis added)

In this regard, it is noted that that all figures and teaching throughout Demetrio illustrate and describe pin 31 having radial protrusions 32 and a single notch 35 disposed in the coupling body 21 for the protrusions. Therefore, any suggestion or motivation to modify Demetrio by reversing the device to include slots on plunger 10 and projections 32 on the alleged first body member 21 would not be an obvious design choice because it would change the principle operation as disclosed in Demetrio.

Accordingly, in view of the foregoing amendments and remarks, the Office is respectfully requested to reconsider and withdraw the rejections of claim 23.

In view of all of the foregoing, Applicants submit that this case is in condition for allowance and such allowance is earnestly solicited.

Respectfully submitted,

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